

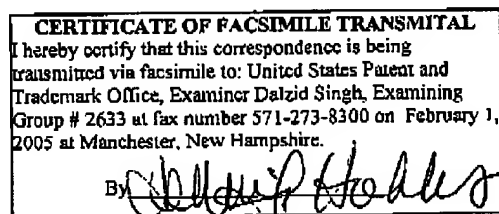
FEB 01 2006

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

In re Appln of: TRISCHITTA, Patrick Ross Atty. Docket: Trischitta 4
Title: POWER FEED ARRANGEMENT USING AGGREGATE SEGMENTS
Serial No.: 09/413,792 Art Unit: 2633
Filed: October 7, 1999 Examiner: Singh, Dalzid
Customer No.: 32047 Confirmation No.: 2431

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In accordance with the Pre-Appeal Brief Conference Pilot Program set forth at 1296 OG 67 (July 12, 2005) Applicant's hereby submit this Pre-Appeal Brief Request For Review concurrently with a Notice of Appeal and request that an appeal conference be conducted in the above-referenced application. Applicants respectfully submit that the rejections of record are not legally proper. Accordingly Applicants request that the application be allowed on the existing claims, or in the alternative, prosecution on the merits be reopened. If prosecution on the merits is reopened, Applicants respectfully request that a proposed amendment accompany the panel's decision proposing changes that may result in an indication of allowability

Arguments in support hereof begin on page 2 of this paper.

ARGUMENTS

The only rejection set forth in the Final Action Dated November 1, 2005 is the rejection of claims 1, 3-15 and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over the prior art disclosed by applicant as FIGS. 2 and 4 (Reference 1) in view of Wood et al. (US Patent Number 6,078,008, hereinafter "Wood").

Three criteria must be met to establish a *prima facie* case of obviousness:

- (1) the combined references must teach or suggest all of the claimed limitations;
- (2) there must be some suggestion or motivation in the references to combine the reference teachings; and
- (3) there must be some expectation of success.

See, e.g., *MPEP 2143*; *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). In establishing a *prima facie* case of obviousness under 35 USC 103, it is incumbent upon the Examiner to provide a "clear and particular" showing of "actual evidence" of a suggestion, teaching, or motivation to combine references. *In re Dembiczak*, 50 USPQ 2d, 1614, 1617 (Fed. Cir. 1999). "Broad conclusory statements regarding the teachings of multiple references, standing alone, are not evidence." *Id.*, citing *McElmury v. Arkansas Power and Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) (internal quotations omitted) (emphasis added).

In fact, in *In re Dembiczak* the Court of Appeals for the Federal Circuit recognized that "rigorous application" of the requirement for a showing of a teaching or motivation to combine references is the "best defense against the subtle but powerful attraction" of improper hindsight-based obvious analysis. *Id.*; See also, *Para-Ordnance Manufacturing, Inc. v. SGS Importers International, Inc.*, 73 F.3d 1085, 37 USPQ2d 1237 (Fed. Cir. 1995). ("obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor"). This is especially true in cases where the ease with which the invention may be understood "may prompt one to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Id.* citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

The Examiner in the present application has failed to set forth a *prima facie* case of

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obviousness. A glaring example of this may be found with respect to the rejection of claim 9. Dependent claim 9 requires that "signal carrying lines of said first cable are communicatively isolated from said signal carrying lines of said second cable." That is, claim 9 requires that the electrical power conductors of the first and second cables be connected, as set forth in claim 1, but that the data carrying lines of the first and second cables are isolated. At page 6 of the Final Action dated November 1, 2005, the Examiner simply states:

Regarding claim 9, as shown in Fig 4, reference 1 shows that signal carrying lines of said first cable (401) are communicatively isolated from said signal carrying lines of said second cable.

The Examiner provides no statement or evidence of anything in the prior art that would have provided either: (1) a suggestion or motivation in the references to combine the reference teachings, or (2) any expectation of success. Instead, the Examiner simply argues that the limitation added in claim 9, may be found in Reference 1. Apart from the merits of this argument, it is never sufficient for an Examiner to merely identify elements of the claims in the prior art, as the Examiner has done with respect to claim 9. Instead, the Examiner must provide a "clear and particular" showing of "actual evidence" of a suggestion, teaching, or motivation to combine references. *In re Dembiczak*, 50 USPQ 2d, 1614, 1617 (Fed. Cir. 1999). The Examiner clearly has not met this standard with respect to claim 9. This deficiency also exists at least with respect to claims 12, 13 and 14.

Concerning the substance of the references, Applicants repeat the arguments regarding Reference 1 set forth at pages 6-7 of Applicant's Amendment Pursuant to 37 CFR 1.111 filed August 17, 2205. Wood has been cited only to show that "connecting to cables without use of a switch is well known," and not as providing the teachings the Examiner has acknowledged to be missing from Reference 1. *Official Action dated November 1, 2005, page 3*. Independent claims 1 and 11 thus could not have been obvious in view of Reference (1), which illustrates the very problem to be solved by the claimed invention, and Woods, which teaches a load-breaking and returning apparatus for land-based power distribution.

Moreover, there is nothing in the cited references, and the Examiner has identified nothing in the prior art, that would have prompted one skilled in the art to combine the teachings

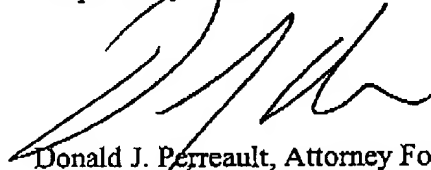
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of the references to achieve a system as set forth in at least claims 9, 12, 13 and 14 or that would have provided any expectation of success in making such a combination. For example, there is nothing in the references that teaches or suggests to connect the power conductors of the cables while isolating the data carrying lines of the cables, as set forth in claim 9.

Applicants respectfully submit that the Examiner has not set forth a *prima facie* case of obviousness since (1) the Examiner has not provided a sufficient showing of actual evidence of a motivation to combine the references, at least with respect to claims 9, 12, 13 and 14 and, and (2), even if such a showing was presented, the references fail to teach or suggest the claimed invention. The rejections of record are not legally proper. Applicants, therefore, request that the application be allowed on the existing claims, or in the alternative, prosecution on the merits be reopened. If prosecution on the merits is reopened, Applicants respectfully request that a proposed amendment accompany the panel's decision proposing changes that may result in an indication of allowability.

No fees are believed to be due. In the event there are any fee deficiencies, please charge them (or credit any overpayment) to our Deposit Account No. 50-2121.

Respectfully submitted,



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